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Docket No. 740165-279

4/22/03



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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In re Patent Application of:)
Bunji INAGAKI et al.) Group Art Unit: 2872
Serial No. 09/752,836)
Filed: January 3, 2001) Examiner: Mark A. Robinson
For: VEHICLE MIRROR ASSEMBLY)
AND METHOD FOR ASSEMBLING)
THE SAME)

Commissioner for Patents
Washington, D.C. 20231

Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192

This brief is in furtherance of the Notice of Appeal filed October 7, 2002.

The fees required under 37 CFR 1.17 and any required petition for extension of time for filing this brief and fees thereof, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

It is requested that, in accordance with USPTO policy, an appeals conference to be held prior to the Examiner's Answer. It is also requested that a Quality Assurance Specialist be a member of the panel.

This brief is transmitted in triplicate, 37 CFR 1.192 (a).

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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeals to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1 and 3-21 as set forth in the Office Action mailed July 8, 2002. A timely Notice of Appeal was filed October 7, 2002.

Real Party In Interest

The real party in interest is Kabushiki Kaisha Tokai-Rika-Denki-Seisakusho, of Aichi-ken, Japan.

Related Appeals And Interferences

There are no applications, related to the instant application, which are involved in an appeal or interference before the USPTO Board of Patent Appeals and Interferences.

Status Of The Claims

Claims 1 and 3-21 are pending in the application.

Claims 2 has been canceled.

Claims 1, 3-7, 10, 11, 15 and 18 are rejected under 35 U.S.C. §102(b).

Claims 8, 9, 12-14, 16, 17 and 19-21 are rejected under 35 U.S.C. §103(a).

Appendix I provides a clean copy of the claims on appeal.

Status Of Amendments

An Amendment was filed May 2, 2002 in response to the first Office Action dated January 24, 2002. An Amendment has been filed on even date herewith, under 37 C.F.R. 1.116, after the Final Rejection dated July 8, 2002 for the purpose of correcting typographical errors or setting forth consistent claim terminology in claims 3, 4, 7 and 8. The Appendix I presents claims 3, 4, 7 and 8 assuming that the Amendment, under 37 C.F.R. 1.116, has been entered for the purpose of appeal.

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Summary Of The Invention

The presently claimed invention is directed to a vehicle mirror assembly and methods of manufacturing wherein the mirror assembly is mounted to a vehicle body to enable viewing to the rear of the vehicle. The vehicle mirror assembly includes, with reference to Figure 1:

- (A) a mirror 14 having a back surface and an outer peripheral surface;
- (B) a mirror visor 38 supporting the mirror, the mirror visor having a visor cover 40 opposing the back surface of the mirror 14, and a visor rim 42 covering the outer peripheral surface of the mirror 14;
- (C) a bracket 24 accommodated within the mirror visor;
- (D) a door mirror stay 12 adapted to be connected to the door of a vehicle, and
- (E) a retracting unit 16 having a stand 18 and a rotating portion 20 connecting said bracket to said door mirror stay 12.

The vehicle mirror assembly can further include a mirror surface adjustment unit 30 disposed between the bracket and the mirror and connected to the bracket and the mirror.

With reference to Figures 3-6, one claimed method of manufacturing the vehicle mirror assembly, wherein the assembly includes a mirror 14 having an outer peripheral surface and a back surface, a mirror visor 38 having a visor cover 40 for covering the back surface of the mirror 14, a visor rim 42 for covering the outer peripheral surface of the mirror 14, a retracting unit 16, and a bracket 24 having opposite surfaces, includes the steps of:

- mounting the retracting unit 16 to the bracket 24;
- mounting the visor rim 42 to one surface of the bracket 24;
- mounting the visor cover 40 to one of the other surface of the bracket 24 and the visor rim 42 from the other surface side of the bracket 24, and
- mounting the retracting unit 16 to a door mirror stay 12 to mount the vehicle mirror assembly to the door of a vehicle.

The method of manufacturing the vehicle mirror assembly can further utilize, as shown in Figures 3-6, a bracket jig 48 for receiving the bracket 24 in proper position for receiving the remaining mirror components.

Another claimed manufacturing method for the vehicle mirror assembly, wherein the assembly includes a mirror 14 having an outer peripheral surface and a back surface, a mirror visor 38, 40, 42 for covering the back surface and outer peripheral surfaces of the mirror 14, a retracting unit 16 having a stand 18 and a rotating portion 20, and a bracket 24 having opposite surfaces for accommodation within the mirror visor 42, includes the steps of:

- mounting the rotating portion 20 of the retracting unit 16 to the bracket 24;
- mounting the mirror 14 to one surface of the bracket 24;
- mounting the mirror visor 40 to the other surface of the bracket 24 from the other surface side of the bracket 24, and
- mounting the stand 18 of the retracting unit 16 to a door mirror stay 12 to mount the vehicle mirror assembly 10 to the door of a vehicle.

While still another claimed method of manufacturing the vehicle mirror assembly, wherein the assembly includes a mirror 14 having an outer peripheral surface and a back surface, a mirror visor 38,40,42 for covering the back surface and outer peripheral surfaces of the mirror 14, a retracting unit 16 having a stand 18 and a rotating portion 20, and a bracket 24 having opposite surfaces for accommodation within the mirror visor 42, includes the steps of:

- mounting the rotating portion 20 of the retracting unit 16 to the bracket 24;
- mounting the mirror 14 to one surface of the bracket 24;
- mounting the mirror visor 40 to the other surface of the bracket 24 from the other surface side of the bracket 24;
- mounting the stand 18 of the retracting unit 16 to a door mirror stay 12 to mount the vehicle mirror assembly 10 to the door of a vehicle, and further including the steps of
- placing the bracket 24 on a bracket jig 48 before mounting the mirror 14 to one surface of the bracket 24 (Figure 5);
- removing the bracket 24 from the bracket jig 48 after mounting the mirror 14 and before mounting the mirror visor 40,
- wherein removing the bracket 24 from the bracket jig 48 includes repositioning the bracket 24 to face in the opposite direction (Figure 6).

Each of the methods of manufacturing the vehicle mirror assembly can also include mounting the mirror 14 to the bracket 24 via a mirror surface adjustment unit 30.

Issues For Review By The Board

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Does Polzer teach each and every feature/element of the claimed vehicle mirror assembly set forth in claims 1 and 3-6?
2. Does Polzer teach each and every method step of the claimed invention set forth in claims 7, 10, 11, 15 and 18?
3. Does Polzer render obvious the claimed methods of manufacturing a vehicle mirror assembly, set forth in claims 8, 9, 12-14, 16, 17 and 19-21, by teaching or suggesting to one of ordinary skill in the prior art each and every step of the claimed methods?

Grouping Of Claims

In regards to patentability, unless otherwise indicated, the claims within each group stand or fall together. Reasons supporting the Appellents' position that the claims in each group are separately patentable are provided in the "Arguments" section in accordance with Rule 1.192.

The claims are grouped as follows:

Claims 1, 3-6 to the vehicle mirror assembly

Claims 7-21 to methods of manufacturing the vehicle mirror assembly

Arguments

The §102 Anticipation Rejection

The Examiner states that claims 1, 3-7, 10, 11, 15 and 18 are anticipated by Polzer, U.S. Patent 5,245,480.

Claim 1 recites a vehicle mirror assembly that comprises a mirror 14, a mirror visor 38 that supports the mirror, a bracket 24 accommodated within the mirror visor 38, a door mirror stay 12 adapted to be connected to the door of the vehicle, and a retracting unit 16 having a

stand 18 and a rotating portion 20 connecting said bracket to said door mirror stay. The stand 18 and box-like rotating portion 20 are clearly illustrated in Figure 1. The instant specification, at page 6, lines 9-16, and Figure 1, clearly provides a single definition of the claimed 'retracting unit' and 'stand' and 'rotating portion' components as follows:

[a] retracting unit 16 is provided at the vehicle upward side of the door mirror stay 12. The retracting unit 16 has a stand 18 at the vehicle downward side thereof and a rotating portion 20 at the vehicle upward side thereof. The stand 18 is fixed to the door mirror stay 12 by a predetermined number of screws 22 (in the present embodiment, three screws 22) so that the retracting unit 16 is supported by the door mirror stay 12. The rotating portion 20 is rotatable with respect to the stand 18. (Emphasis added)

The Examiner asserts that the Polzer '480 patent does indeed teach such a 'retracting unit' and directs attention to column 2, lines 39-45, and 57-61 of this reference. However, a review of this portion of Polzer reveals only the combination of a bracket 3 connected to an armlike extension 10, which is not remotely equivalent to the claimed 'retracting unit.'

Critically missing from the armlike extension 10 are the specifically recited 'stand' and 'rotating portion' of a retracting unit. The armlike extension 10 of Polzer '480 is mounted directly to the arm 9 (see Figures 1 and 2) projecting from the mirror base 2, where elements 9 and 2 are analogous to the door mirror stay 12 of the present claims 1 and 3-6. The mounting is achieved via a tubular rivet 75 extending into the tubular bore 12 of the armlike extension 10. This structure enables pivoting of the bracket (and mirror) relative to the vehicle body. This 'retracting' structure of Polzer '480 is completely devoid of the 'stand' and 'rotating portion' of the presently claimed invention.

The Appellents assert that the Examiner has not given the claimed terminology, i.e., 'stand' and 'rotating portion' the proper meaning as defined by the instant specification as is required by law. *Serrano v. Telular Corp.*, 111 F.3d 1578, 42 USPQ2d 1538 (Fed. Cir. 1997). For anticipation to exist, the claimed invention, described via appropriately construed claims, must be the same as that disclosed in the reference. *Gloverbel SA v. Northlake Mktg. & Supp., Inc.*, 33 USPQ 2nd 1496 (Fed.Cir. 1996) As a consequence, absence from a reference on any

claimed element negates anticipation. *Klaster Speedsteal AB v. Crucible, Inc.*, 230 USPQ 81 (Fed.Cir. 1986). Since, as discussed in the MPEP Chapter 2111, the Examiner must give each element of the claims the broadest reasonable interpretation consistent with the specification and with the interpretation one of ordinary skill in the art would reach, see *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Cortright*, 165 F.3d 1353, 49 USPQ 2d 1464 (Fed. Cir. 1999), and since the Appellants have specifically provided a single definition of the 'retracting unit' as having 'stand' and 'rotating portion' elements of a particular structure and functionality, the Examiner's reliance on the armlike extension 10, which is a single element having the single function of rotating on rivet 75, to meet the claimed limitation of a 'retracting unit' is inappropriate and in error. The armlike extension 10 of Polzer '480 cannot at the same time be rotatable and fixed as is required of the 'stand' and 'rotating portion' of the 'retracting unit' of the instant claims. Consequently, Polzer '480 cannot anticipate the claimed inventions since each and every feature of the claimed invention is not explicitly or implicitly taught.

Looking again at the teachings of Polzer '480, the support plate 3 of the rear view mirror includes the armlike extension 10 mentioned above that is directly mounted to the mirror base elements 9, 2 in order to remain vibration free as discussed at column 4, lines 7-9:

the support plate 3 is vibration-free mounted to the mirror base 2
and suppresses any vibrations in view of its beads and
impressions.

This single-piece direct connection of the bracket to the mirror base enables the vibration-free mounting. Such a structure is distinctly different from the 'retracting unit' of the claims which requires a 'stand' (fixedly) mounted to the door mirror stay by definition and a box-like 'rotating portion' (relative to the stand) mounted to the bracket as defined in the specification. Polzer '480 would not teach one of ordinary skill in the prior art to contrive a single piece unit (armlike extension 10) mounted directly to the mirror base in order to avoid vibration as including the 'retracting unit' having multiple elements, i.e., the 'stand' and 'rotating portion' presently claimed, since such an arrangement would be expected by one of ordinary skill in the

prior art to increase the likelihood of the undesired vibration. Simply put, the Examiner has neither properly construed the claims, nor has the Examiner shown that the 'stand' and 'rotating portion' of the claimed 'retracting unit' are the same as that of Polzer '480.

Similarly, claims 7 and 15 recite a method for assembling a vehicle mirror assembly having a 'retracting unit' that comprises the steps of "mounting the rotating portion of the retracting unit to the bracket..." and then "mounting the stand of the retracting unit to a door mirror stay to mount the vehicle mirror assembly to the door of the vehicle . . ." Since Polzer '480 does not teach the 'stand' and a 'rotating portion' of the 'retracting unit' presently claimed invention, Polzer cannot teach or suggest the step of "mounting the stand of the retracting unit to a door mirror stay to mount the vehicle mirror assembly to the door of the vehicle." Therefore, the claims 7, 10, 11, 15 and 18 cannot be anticipated by the teachings of Polzer '480.

The §103 Obviousness Rejection

The Examiner states that claims 8, 9, 12-14, 16, 17 and 19-21 are obvious in view of the teachings of Polzer, U.S. Patent 5,245,480, and elaborates on the teachings of Polzer '480 by stating that the use of jig to hold the bracket prior assembling the mirror components of Polzer '480 would have been obvious to one of ordinary skill in the prior art since jigs are "commonly used in assembling vehicle mirror devices."

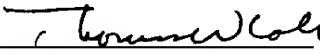
In traversal of this rejection, the Appellants again note that Polzer '480 neither specifically teaches the 'stand' and 'rotating portion' elements of the 'retracting unit' as discussed above, nor suggests that the armlike extension 10 can be modified to provide a 'stand' structure which is (fixedly) mounted to the door mirror stay 9 while still allowing rotation of the 'rotating portion' relative to the stand, which is attached to the bracket, as presently set forth in the claims. Similarly, without a teaching or suggestion to provide the 'retracting unit' with a 'stand' and 'rotating portion' the patentee cannot teach or suggest a step of "mounting the stand of the retracting unit to a door mirror stay to mount the vehicle mirror assembly to the door of the vehicle." Additionally, since the problem of vibration is

solved by the single piece unit (armlike extension 10) of Polzer '480, the patentee does not suggest to one of ordinary skill in the prior art the presently claimed 'retracting unit' with multiple elements, i.e., 'stand' and 'rotating portion,' for the reasons mentioned above.. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 712 F2d 1540, 220 USPQ 303 (Fed. Cir 1983. *In re Spinnoble*, 405 F2d 578, 160 USPQ 237 (CCPA 1969) Therefore, without some suggestion or motivation to modify the armlike extension 10 of Polzer '480 to provide a 'retracting unit' having a 'stand' and 'rotating portion' as claimed, a *prima facie* case of obviousness has not been set forth with regard to method claims 8, 9, 12-14, 16, 17 and 19-21. *In re Rouffet*, 149 F3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998)

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejections by the Examiner and mandate the allowance of Claims 1 and 3-21.

Respectfully submitted,



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APPENDIX I - CLAIMS ON APPEAL

1. A vehicle mirror assembly comprising:
 - (A) a mirror having a back surface and an outer peripheral surface;
 - (B) a mirror visor supporting the mirror, the mirror visor having a visor cover opposing the back surface of the mirror, and a visor rim covering the outer peripheral surface of the mirror;
 - (C) a bracket accommodated within the mirror visor;
 - (D) a door mirror stay adapted to be connected to the door of a vehicle, and
 - (E) a retracting unit having a stand and a rotating portion connecting said bracket to said door mirror stay.
3. The vehicle mirror assembly according to Claim 1 further comprising a bracket accommodated within the mirror visor, and a mirror surface adjustment unit disposed between the bracket and the mirror and connected to the bracket and the mirror.
4. The vehicle mirror assembly according to Claim 1, further comprising a bracket accommodated within the mirror visor, and wherein the bracket includes opposite surfaces, and the visor rim is mounted to the surface of the bracket from the mirror side, and the visor cover is mounted from the opposite surface side of the bracket.
5. The vehicle mirror assembly according to Claim 3, wherein the visor cover is mounted to one of the bracket and the mirror surface adjustment unit.
6. The vehicle mirror assembly according to Claim 5 further comprising a fastener structure including a plurality of fastener elements provided at the visor cover, and a plurality

of corresponding fastener elements provided at one of the bracket and the mirror surface adjustment unit.

7. A method for assembling a vehicle mirror assembly, wherein the assembly includes a mirror having an outer peripheral surface and a back surface, a mirror visor having a visor cover for covering the back surface of the mirror, a visor rim for covering the outer peripheral surface of the mirror, a retracting unit, and a bracket having opposite surfaces, the method comprising:

- mounting the retracting unit to the bracket;
- mounting the visor rim to one surface of the bracket;
- mounting the visor cover to one of the other surface of the bracket and the visor rim from the other surface side of the bracket, and
- mounting the retracting unit to a door mirror stay to mount the vehicle mirror assembly to the door of a vehicle.

8. The method according to Claim 7, further comprising placing the bracket on a bracket jig before mounting the visor rim to one surface of the bracket.

9. The method according to Claim 7, further comprising disposing the bracket substantially horizontally before mounting the visor rim.

10. The method according to Claim 7, further comprising mounting the mirror to one surface of the bracket after mounting the visor rim before mounting the visor cover.

11. The method according to Claim 10, wherein the mirror is mounted via a mirror surface adjustment unit to the bracket.

12. The method according to Claim 8, further comprising removing the bracket from the bracket jig after mounting the visor rim and before mounting the visor cover.

13. The method according to Claim 12, wherein removing the bracket from the bracket jig includes repositioning the bracket to face in the opposite direction.

14. The method according to Claim 13, wherein the bracket is repositioned substantially horizontally.

15. A method for assembling a vehicle mirror assembly, wherein the assembly includes a mirror having an outer peripheral surface and a back surface, a mirror visor for covering the back surface and outer peripheral surfaces of the mirror, a retracting unit having a stand and a rotating portion, and a bracket having opposite surfaces for accommodation within the mirror visor, the method comprising:

mounting the rotating portion of the retracting unit to the bracket;

mounting the mirror to one surface of the bracket;

mounting the mirror visor to the other surface of the bracket from the other surface side of the bracket, and

mounting the stand of the retracting unit to a door mirror stay to mount the vehicle mirror assembly to the door of a vehicle.

16. The method according to Claim 15, further comprising placing the bracket on a bracket jig before mounting the mirror to one surface of the bracket.

17. The method according to Claim 15, further comprising disposing the bracket substantially horizontally before mounting the mirror to one surface of the bracket.

18. The method according to Claim 15, wherein the mirror is mounted via a mirror surface adjustment unit to the bracket.

19. The method according to Claim 16, further comprising removing the bracket from the bracket jig after mounting the mirror and before mounting the mirror visor.

20. The method according to Claim 19, wherein removing the bracket from the bracket jig includes repositioning the bracket to face in the opposite direction.

21. A method for assembling a vehicle mirror assembly, wherein the assembly includes a mirror having an outer peripheral surface and a back surface, a mirror visor for covering the back surface and outer peripheral surfaces of the mirror, a retracting unit having a stand and a rotating portion, and a bracket having opposite surfaces for accommodation within the mirror visor, the method comprising:

mounting the rotating portion of the retracting unit to the bracket;

mounting the mirror to one surface of the bracket;

mounting the mirror visor to the other surface of the bracket from the other surface side of the bracket;

mounting the stand of the retracting unit to a door mirror stay to mount the vehicle mirror assembly to the door of a vehicle, and further including the steps of

placing the bracket on a bracket jig before mounting the mirror to one surface of the bracket;

removing the bracket from the bracket jig after mounting the mirror and before mounting the mirror visor,

wherein removing the bracket from the bracket jig includes repositioning the bracket to face in the opposite direction.